

cancelled. Claims 45-53 have been added. Claims 1-7, 9-20, and 45-53 are now pending.

Reexamination and reconsideration of the rejections are respectfully requested in light of the enclosed amendments and these remarks.

#### **Claim Rejections – 35 U.S.C. § 112**

Claim 2 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 has been amended above to improve its form and it is believed that said amendment obviates the rejection under 35 U.S.C. 112.

#### **Claim Rejections – 35 U.S.C. § 103**

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kassab (USPN 6,258,200). In order to establish *prima facie* obviousness under 35 U.S.C. § 103(a), three basic criteria must be met, namely: (1) there must be some suggestion or motivation to combine the references or modify the reference teaching; (2) there must be a reasonable expectation of success; and (3) the reference or references when combined must teach or suggest each claim limitation. Applicant submits that the Office Action failed to state a *prima facie* case of obviousness, and therefore the burden has not properly shifted to Applicant to present evidence of nonobviousness. Applicant respectfully asserts that Kassab fails to disclose or suggest all of the limitations of the pending claims. Specifically, Applicant asserts that Kassab does not disclose a) a substantially transparent information sheet, b) a manufacturer's suggested retail price (MSRP) information on the sheet, and c) wherein the information sheet does not substantially impair the vision of a driver of the motor vehicle, as now claimed.

Before addressing the Kassab reference as it has been applied to the present invention, a brief overview of the present invention is hereby provided. As defined more clearly in the claims,

as amended, the present invention relates to an MSRP label that is attached to a window, such as the windshield of an automobile. Importantly, the MSRP label of the present invention is substantially clear such that a driver of the automobile can substantially see through the MSRP label while driving the automobile. This is very important for a number of reasons. First, the MSRP label is different from other labels that may be placed on an automobile window since the MSRP label contains a significant amount of information. As such, a relatively large portion of the window is consumed with an MSRP label. Using a prior art MSRP label, i.e., one that is not substantially clear, creates a significant visual impairment to the driver. Second, the MSRP label must remain on the car during test drives and other drives until the car is ultimately purchased. Consequently, drivers are simply not allowed to remove the MSRP label during a "pre-purchase" drive of the automobile so safety is sacrificed in order to comply with the law.

Kassab is directed to a method for affixing stickers and artwork to surfaces and particularly car windows that allows for easy removal. Kassab is not concerned with providing substantially transparent sheets or improving driver vision while complying with the law. In fact, Kassab clearly states that the stickers and artwork are primarily non-transparent. "In addition, having too many city stickers 30 mounted on the windshield creates blind spots thereby reducing a driver's vision through the windshield 12." Kassab, Col. 8, lines 1-4. In addition, Kassab recommends removing any extra static-cling film in FIG. 6 and its related discussion. "The portions of the static-cling film 20 that extend beyond the windshield sticker 30 are trimmed to conform to the size of the windshield sticker 30." Kassab, Col. 6, lines 33-36. While the affixing device in Kassab (the static-cling film) may be transparent, it is clear that the resulting sticker/film combination is not substantially transparent. Furthermore, the static-cling film is not analogous to an information sheet as it has no information on it - it is blank - until a

sticker or artwork is affixed to it (rendering the combination no longer substantially transparent). Since Kassab clearly does not show the substantially transparent information sheet element of claims 1, 11 and 16, it cannot form the basis of a 35 U.S.C. § 103(a) rejection for those claims or any depending claims.

The Examiner cites *In re Gulack* (217 USPQ 401, (CAFC 1983)) as support for stating that the MSRP information does not patentably distinguish the present invention from Kassab. The Applicant respectfully traverses this conclusion, because *Gulack*, as it relates to the present invention supports the finding that the MSRP information alone patentably distinguishes the present invention from Kassab. *Gulack* states that "[w]here the printed subject matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art." *Gulack* 217 USPQ 401 at 403. The test in *Gulack* for functional relationship is "the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." *Id.* The court found in *Gulack* that random items of text on a hat band were not functionally related but that an infinite number series on a ring were functionally related as the ring, also, is infinite.

In the present invention, there is a functional relationship between the MSRP information and the sheet. The MSRP information must be on the car window, but its contrasting background does not, and the transparent sheet allows it to be there safely. In fact, the MSRP information in this case could be considered the substrate as it is the structural element that is required by law to be on the window. The present invention is directed to displaying that element as safely as possible. Therefore, *Gulack* requires the finding that MSRP information does render the present invention patentably distinct from Kassab, wherein the contents of the sticker are irrelevant to the affixing device. Therefore pending claims 1-7, and 9-20 are

patentably distinguishable from Kassab because of this functional relationship.

Kassab also does not teach or disclose the claimed element of an information sheet that does not substantially impair the vision of a driver of the motor vehicle. Under Kassab, there is no difference to the driver between affixing the sticker directly to a window or using Kassab's affixing device to affix the sticker. The driver's vision will be equally impaired either way. Since Kassab clearly does not show this element of claims 1 and 11, it cannot form the basis of a 35 U.S.C. § 103(a) rejection for those claims or any depending claims.

Furthermore, with regard to claim 16, Kassab clearly does not teach or disclose a removable opaque sheet that may be affixed to a substantially transparent information sheet to provide contrast allowing for easy reading of the MSRP information on the transparent information sheet. Since Kassab clearly does not show this element of claims 16, it cannot form the basis of a 35 U.S.C. § 103(a) rejection of it.

As claims 1, 11 and 16 are now allowable for the reasons given above, so too are all the claims dependent therefrom. Thus, Applicant respectfully requests that the Examiner withdraw his rejections and find the pending claims allowable.

### **New Claims**

New claims 45-53 have been added to claim a motor vehicle comprising a label as described in the application and claimed in claims 1-7, 9, and 10. Therefore, as claims 1-7, 9, and 10 are now in a condition for allowance, so too are claims 45-53.

### **Conclusion**

As originally filed, the present application included 43 claims, 6 of which were independent. As the result of a restriction requirement, Applicant elected Claims 1-20 for prosecution, 3 of which are independent. As amended, the present application now includes 28

claims, 4 of which are independent. It is believed that the application is now in condition for allowance, and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Mike Anderson	Examiner:	Henderson, Mark T.
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Filed:	August 10, 2001	Docket No.:	40229.1-US-U1
Title:	TRANSPARENT MSRP LABEL		

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**AMENDMENT MARK UP**

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Please cancel claim 8, amend claims 1, 2 and 11, and add new claims 45-53 as shown below.

1. (Amended) A label for displaying manufacturer's suggested retail price information for a motor vehicle on a window of the motor vehicle, said label comprising:

a substantially transparent information sheet; and

text on the information sheet, wherein the text provides manufacturer's suggested retail price information, the text visible through the window when said label is affixed to the window of the motor vehicle, the text is printed on the information sheet, and wherein the information sheet does not substantially impair the vision of a driver of the motor vehicle.

2. (Amended) A label as defined in claim 1, wherein the information sheet is formed from a material exhibiting static cling properties, thereby permitting the [base] information sheet to be removably affixed to the window of the motor vehicle.

8. (Cancelled)

11. (Amended) A label for displaying manufacturer's suggested retail price information for a motor vehicle on a window of the motor vehicle, said label comprising:

a substantially transparent information sheet having text printed thereon, wherein the text

provides manufacturer's suggested retail price information, the text visible through the window of the motor vehicle when the label is affixed to the window of the motor vehicle, the text being printed on the information sheet, and wherein the information sheet does not substantially impair the vision of a driver of the motor vehicle; and

a substantially opaque base sheet, formed from a material exhibiting static-cling properties, thereby permitting the base sheet to be removably affixed to the information sheet when the information sheet is affixed to the window of the motor vehicle.

45. (New) A motor vehicle subject to a legal requirement to display required information, the motor vehicle having a label for displaying at least the required information including manufacturer's suggested retail price information for the motor vehicle on a window of the motor vehicle, said label comprising:

a substantially transparent information sheet; and  
text on the information sheet, wherein the text provides manufacturer's suggested retail price information, the text visible through the window when said label is affixed to the window of the motor vehicle, the text is printed on the information sheet, and wherein the information sheet does not substantially impair the vision of a driver of the motor vehicle.

46. (New) A motor vehicle as defined in claim 45, wherein the information sheet is formed from a material exhibiting static cling properties, thereby permitting the information sheet to be removably affixed to the window of the motor vehicle.

47. (New) A motor vehicle as defined in claim 45, wherein the information sheet is formed from a flexible plastic material exhibiting static cling properties, thereby permitting the information sheet to be removably affixed to the window of the motor vehicle.

48. (New) A motor vehicle as defined in claim 47, wherein the information sheet comprises polyvinyl chloride.
49. (New) A motor vehicle as defined in claim 46, wherein the text is white in color.
50. (New) A motor vehicle as defined in claim 46, wherein the text provides information related to the motor vehicle's fuel efficiency.
51. (New) A motor vehicle as defined in claim 47, wherein the text provides information related to country of origin of manufacture of parts of the vehicle.
52. (New) A motor vehicle as defined in claim 46, wherein the text is flexographically printed on the information sheet.
53. (New) A motor vehicle as defined in claim 46, wherein the text is screen printed on the information sheet.